

9-16-04

1632



PATENT

Attorney Docket No.: 27110-701

JFLW

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

re Application)	<u>PATENT APPLICATION</u>
Inventor(s): Paul Roben and Anthony C. Stevens)	
Application No.: 09/528,742)	Art Unit: 1632
Filed: March 20, 2000)	Examiner: Joseph T. Woitach
Title "Methods for Identifying and Isolating Tissue-Specific Lumen-Exposed Molecules")	
)	

Commissioner of Patents
P.O. Box 1450
Alexandria, VA 22313-1450

SUPPLEMENTAL INFORMATION DISCLOSURE

STATEMENT UNDER 37 C.F.R. §1.97

Sir:

Applicants hereby submit an Information Disclosure Statement along with attached form(s) PTO/SB/08. A copy of each listed publication is being submitted herewith, along with a concise explanation of information in a foreign language, if any, pursuant to 37 C.F.R. §1.97-1.98.

Applicants respectfully request that the listed information be considered by the Examiner and be made of record in the above-identified application. Applicants further request that the Examiner initial and return the attached form(s) PTO/SB/08 in accordance with MPEP §609.

Applicants reserves the right to establish the patentability of the claimed invention over any of the information provided herewith, and/or to prove that this information may not be prior art, and/or to prove that this information may not be enabling for the teachings purportedly offered.

This statement is not intended to represent that a search has been made or that the information cited in the statement is, or is considered to be, prior art or material to patentability as defined in §1.56.

- This statement qualifies under 37 C.F.R. §1.97, subsection (b) because:
 - (1) It is being filed within 3 months of the application filing date and is other than a continued prosecution application under § 1.53(d)
-- OR --
 - (2) It is being filed within 3 months of entry of a national stage
-- OR --
 - (3) It is being filed before the mail date of the first Office Action on the merits
-- OR --
 - (4) It is being filed before the mailing of a first Office Action after the filing of a request for continued examination under § 1.114.
- 37 C.F.R. §1.97(c). If this statement is being filed after the latest of: (1) three months beyond the filing date of a national application; (2) three months beyond the date of entry of the national stage as set forth in §1.491 in an international application; or (3) the mailing date of a first Office action on the merits, but before the mailing date of the earlier of a final office action under §1.113 or a notice of allowance under §1.311, then:
 - a certification as specified in §1.97(e) is provided below; or
 - a fee of \$180.00 as set forth in §1.17(p) is authorized below, enclosed, or included with the payment of other papers filed together with this statement.
- 37 C.F.R. §1.97(d). If this statement is being filed after the mailing date of the earlier of a final office action under §1.113 or a notice of allowance under §1.311, but before payment of the issue fee, then:
 - A. a certification as specified in §1.97(e) is completed below; and
 - B. a petition under 37 C.F.R. §1.97(d) requesting consideration of this statement is submitted herewith; and
 - C. a fee of \$130.00 as set forth in §1.17(i)(1) is authorized below, enclosed, or included with the payment of other papers filed together with this statement.
- Copies of each of the references listed on the attached Form PTO/SB/08 are enclosed herewith.
- Copies of references listed on the attached Form PTO/SB/08 are enclosed herewith EXCEPT THAT:
 - In view of the voluminous nature of references, and the likelihood that these references are available to the Examiner in the file history of the parent application (Serial No.), copies are not enclosed herewith.
 - If any of the foregoing publications are not available to the Examiner, Applicant will endeavor to supply copies at the Examiner's request.
- Copies of only foreign patent documents and non-patent literature are enclosed in accordance with 37 CFR 1.98 (a)(2). (The U.S. patents and each U.S. patent application publication listed on the attached Form PTO-1449 are not enclosed because this U.S. patent application was filed after June 30, 2003 or this

international application has entered the national stage under 35 USC §371 after June 30, 2003 (see USPTO waiver of requirement under 37 CFR 1.98 (a)(2)(i)).

- There are no listed references which are not in the English language.
- The relevance of those listed references which are not in the English language is as follows:
- Attached are copies of search report(s) from corresponding patent application(s), submitted in accordance with MPEP 609 D in support of the attached certification under 37 CFR 1.97(e)(1).
- Attached are the following non-published pending patent applications which may be deemed relevant.
- Fee Authorization.* The Commissioner is hereby authorized to charge the above-referenced fees of \$0.00 and charge any additional fees or credit any overpayment associated with this communication to Deposit Account No. 23-2415 (Docket No. 27110-701).

Respectfully submitted,

WILSON SONSINI GOODRICH & ROSATI

Dated: 9/19/04

By: 
Maya Skubatch (Reg. No. 52,505)

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PTO/SB/08A (08-03)

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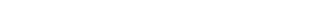
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INFORMATION DISCLOSURE STATEMENT BY APPLICANT <i>(Use as many sheets as necessary)</i>				<i>Complete if Known</i>	
Substitute for form 1449/PTO				Application Number	09/528,742
				Filing Date	March 20, 2000
				First Named Inventor	Paul Roben
				Art Unit	1632
				Examiner Name	Joseph T. Woitach
Sheet	1	of	1	Attorney Docket Number	27110-701

U.S. PATENT DOCUMENTS

FOREIGN PATENT DOCUMENTS

Examiner Initials*	Cite No. ¹	Foreign Patent Document	Publication Date MM-DD-YYYY	Name of Patentee or Applicant of Cited Document	Pages, Columns, Lines, Where Relevant Passages or Relevant Figures Appear	T ⁶
		Country Code ⁴ - Number ⁴ - Kind Code ⁵ (if known)				
7w		WO97/04748	2/13/1997	ADVANCED THERAPIES, INC.		
7w		WO01/71359	9/27/2001	TARGET PRTEIN TECHNOLOGIES		

Examiner Signature		Date Considered	2/17/05
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***EXAMINER:** Initial if reference considered, whether or not citation is in conformance with MPEP 609. Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant.¹ Applicant's unique citation designation number (optional).² See Kinds Codes of USPTO Patent Documents at www.uspto.gov or MPEP 901.04. ³Enter Office that issued the document, by the two-letter code (WIPO Standard ST .3). ⁴For Japanese patent documents, the indication of the year of the reign of the Emperor must precede the serial number of the patent document. ⁵Kind of document by the appropriate symbols as indicated on the document under WIPO Standard ST.16 if possible. ⁶Applicant is to place a check mark here if English language Translation is attached. This collection of information is required by 37 CFR 1.97 and 1.98. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 2 hours to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 (1-800-786-9199) and select option 2.



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : Paul Röben et al. Art Unit : 1643
 Serial No. : 09/528,742 Examiner : Unknown
 Filed : March 20, 2000
 Title : METHODS FOR IDENTIFYING AND ISOLATING TISSUE-SPECIFIC
 LUMEN-EXPOSED MOLECULES

Commissioner for Patents
 Washington, D.C. 20231

INFORMATION DISCLOSURE STATEMENT

UNDER 37 CFR §1.97 and §1.98

Sir:

Enclosed for filing in the above-referenced patent application is a Form PTO-1449, being submitted prior to the first Office Action on the merits. Applicants respectfully request consideration of the remarks and references set forth herein.

The following documents are enclosed herewith:

- copy of Form PTO-1449
- Postcard
- copies of cited references

REMARKS

The references cited on attached form PTO-1449 are being called to the attention of the Examiner. Copies of the references are enclosed. It is respectfully requested that the cited information be expressly considered during the prosecution of this application, and the references be made of record therein and appear among the "references cited" on any patent to issue therefrom.

CERTIFICATE OF MAILING BY FIRST CLASS MAIL

I hereby certify under 37 CFR §1.8(a) that this correspondence is being deposited with the United States Postal Service as first class mail with sufficient postage on the date indicated below and is addressed to the Commissioner for Patents, Washington, D.C. 20231.

June 29 2000

Date of Deposit

Signature

Marian Christopher
 Typed or Printed Name of Person Signing Certificate

Applicant : Paul Roben et al.
Serial No. : 09/528,742
Filed : March 20, 2000
Page : 2

Attorney's Docket No.: 11390-002001

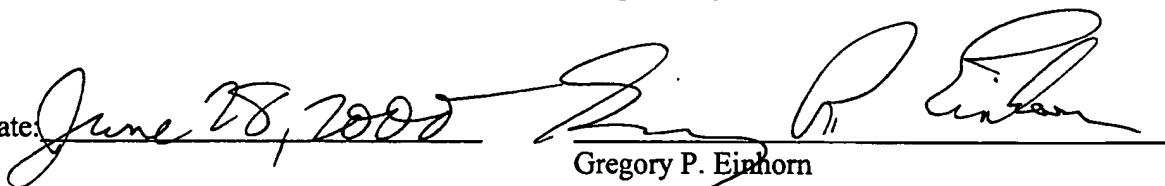
As provided for by 37 CFR 1.97(g) and (h), no inference should be made that the information and references cited are prior art merely because they are in this statement and no representation is being made that a search has been conducted or that this statement encompasses all the possible relevant information.

Applicant believes that no fee is required for submission of this statement, since it is being submitted prior to the first Office Action. However, if a fee is required, the Commissioner is authorized to deduct such fee from the undersigned's Deposit Account No. 06-1050. If necessary, please deduct any necessary additional fees from, or credit any overpayment to, the above-noted Deposit Account.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned or John Wetherell at 858 678 5070.

Respectfully submitted,

Date:



Gregory P. Einhorn
Reg. No. 38,440

Fish & Richardson P.C.
4350 La Jolla Village Drive, Suite 500
San Diego, CA 92122
Telephone: (858) 678-5070
Facsimile: (858) 678-5099

Substitute Form PTO-1449 (Modified) JC14S		U.S. Department of Commerce Patent and Trademark Office	Attorney's Docket No. 11390-002001	Application No. 09/528,742
Information Disclosure Statement by Applicant (Use several sheets if necessary)		Applicant Paul Roben et al.		
(37 CFR §1.98(b)) PATENT & TRADEMARK OFFICE		Filing Date March 20, 2000	Group Art Unit 1643-163	

U.S. Patent Documents

Examiner Initial	Desig. ID	Patent Number	Issue Date	Patentee	Class	Subclass	Filing Date If Appropriate
7W	AA	5,218,700	25 JAN 94				
	AB	5,610,008	11 MAR 97				
	AC	5,776,427	07 JUL 98				
	AD	5,776,770	07 JUL 98				
	AE	5,855,866	05 JAN 99				
	AF	5,914,127	22 JUN 99				
	AG	5,914,312	22 JUN 99				
	AH	5,965,132	12 OCT 99				
	AI	5,994,519	30 NOV 99				
	AJ	6,004,554	21 DEC 99				
	AK	6,068,829	30 MAY 00				

Foreign Patent Documents or Published Foreign Patent Applications

Examiner Initial	Desig. ID	Document Number	Publication Date	Country or Patent Office	Class	Subclass	Translation	
							Yes	No
7W	AL	WO 98/39469	11 SEP 98	PCT				
7W	AM	WO 00/07625	17 FEB 00	PCT				
	AN							
	AO							
	AP							

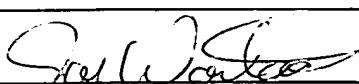
Other Documents (include Author, Title, Date, and Place of Publication)

Examiner Initial	Desig. ID	Document
7W	AQ	Hastie <i>et al.</i> , Identification of Surface Components of Mammalian Respiratory Tract Cilia Cell Motility and the Cytoskeleton 17:317-328 (1990).
	AR	Schnitzer <i>et al.</i> , Separation of Caveolae from Associated Microdomains of GPI-Anchored Proteins Science 269:1435-1439 (September 1995).
	AS	Dentler William L., Nonradioactive Methods for Labeling and Identifying Membrane Surface Proteins Methods in Cell Biology 47:407-411 (1995).
	AT	Schnitzer <i>et al.</i> , Caveolae from luminal plasmalemma of rat lung endothelium: Microdomains enriched in caveolin, Ca ²⁺ -ATPase, and inositol trisphosphate receptor Proc. Natl. Acad. Sci. 92:1759-1763 (February 1995).

Examiner Signature <i>Joe Walen</i>	Date Considered 2/17/03
EXAMINER: Initials citation considered. Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant.	

Substitute Form PTO-1449 (Modified)	U.S. Department of Commerce Patent and Trademark Office	Attorney's Docket No. 11390-002001	Application No. 09/528,742
Information Disclosure Statement by Applicant (Use several sheets if necessary) (37 CFR §1.98(b))		Applicant Paul Roben et al.	Filing Date March 20, 2000 Group Art Unit 1643-1632 

Other Documents (include Author, Title, Date, and Place of Publication)		
Examiner Initial	Desig. ID	Document
ZU	AU	Dentler, William L., Identification of <i>Tetrahymena</i> Ciliary Surface Proteins Labeled with Sulfosuccinimidyl 6-(Biotinamido) Hexanoate and Concanavalin A and Fractionated with Triton X-114. <i>J. Protozool.</i> 39(3):368-378 (May-June 1992). ✓
	AV	Levy-Toledano et al., Streptavidin Blotting: A Sensitive Technique to Study Cell Surface Proteins; Application to Investigate Autophosphorylation and Endocytosis of Biotin-Labeled Insulin Receptors. <i>Endocrinology</i> 133(4):1803-1808 (October 1993). ✓
	AW	Bush et al., Selective isolation of individual cell surface proteins from tissue culture cells by a cleavable biotin label. <i>European Journal of Cell Biology</i> 50:257-262 (December 1989). ✓
	AX	De La Fuente et al., Biotinylation of membrane proteins accessible via the pulmonary circulation in normal hyperoxic rats. <i>Am. J. Physiol.</i> 272(3) Part 1:L461-L470 (March 1997). ✓
	AY	Garlanda et al., Heterogeneity of Endothelial Cells. <i>Arteriosclerosis, Thrombosis and Vascular Biology</i> 17(7):1193-1202 (July 1997). ✓
	AZ	Lamszus et al., Isolation and Culture of Human Neuromicrovascular Endothelial Cells for the Study of Angiogenesis In Vitro. <i>Journal of Neuroscience Research</i> 55:370-381 (February 1999). ✓
	AAA	Craig et al., Endothelial Cells from Diverse Tissues Exhibit Differences in Growth and Morphology. <i>Microvascular Research</i> 55:65-76 (January 1998). ✓
	ABB	Pasqualini, R., Vascular targeting with phage peptide libraries. <i>The Quarterly Journal of Nuclear Medicine</i> 43(2):159-162 (June 1999). ✓
	ACC	Pasqualini et al., Organ targeting <i>in vivo</i> using phage display peptide libraries. <i>Nature</i> 380(28):364-366 (March 1996). ✓
	ADD	Rajotte et al., Molecular Heterogeneity of the Vascular Endothelium Revealed by In Vivo Phage Display. <i>Journal of Clinical Investigation</i> 102(2):430-437 (July 1998). ✓

Examiner Signature 	Date Considered 2/17/05
EXAMINER: Initials citation considered. Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant.	